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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD RODRIGUEZ, THOMAS K. VANDER VLIS,
and PETER J. BULZIGER

Appeal 2009-004023
Application 09/811,823
Technology Center 3600

Decided: September 9, 2009

Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-47 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellants' claimed invention is directed to a method and system for completing and submitting an electronic voter registration form and an electronic ballot over a network (Spec. [0007]). Claims 1 and 23, reproduced below, are representative of the subject matter of appeal.

> 1. A method for completing and submitting an electronic voter registration form and an electronic ballot over a network, comprising the steps of:
>
> transmitting a blank electronic registration form, upon request at a first computer, via a transaction mediator, to the first computer;
>
> transmitting registration information from the first computer, via the transaction mediator, to a computer database that resides on a transaction repository server, all of which are networked together, to establish a registered voter;
>
> transmitting a blank electronic ballot, upon request by the registered voter at a second computer, from the computer database that resides on the transaction repository server, via the transaction mediator, to the second computer; and

transmitting a voted electronic ballot from the second computer, via the transaction mediator, to the computer database that resides on the transaction repository server.

23. A method for completing and submitting an electronic voter registration form and an electronic ballot transmitted over a network, comprising the steps of:

transmitting registration information from a first computer to a computer database that resides on a transaction repository server, all of which are networked together, to establish a registered voter; and

transmitting a voted electronic ballot of the registered voter from a second computer to the computer database that resides on the transaction repository server.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

McClure	US 6,250,548 B1	Jun. 26, 2001
Bayer	US 6,311,190 B1	Oct. 30, 2001

The following rejections are before us for review:

1. Claims 1-19 and 23-40 are rejected under 35 U.S.C. § 103(a) as unpatentable over McClure and Bayer.

2. Claims 20-22 and 41-47 are rejected under 35 U.S.C. § 102(e) as being anticipated by McClure.

THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

With regards to claims 1-19 and 23-40 this issue turns on whether McClure and Bayer disclose the cited claim limitations related to transmitting an electronic ballot to a second computer.

With regards to claims 20-22 and 41-47 this issue turns on whether McClure discloses the specific cited limitations from claims 20, 41, and 47.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:[1]

FF1. McClure discloses an electronic voting system (Title). The casting of the ballot may be conducted over the Internet if the voter is registered (Col. 36:23-50).

FF2. McClure discloses that the identification file requires the voter to register and cast their vote from the same computer. Should the file become corrupted or the voter change computers, they have to start over with the request to vote (Col. 36:52-58).

FF3. McClure at Col. 37:4-36 does not disclose transmitting an electronic ballot to a second computer.

FF4. McClure at (Cols. 36:30-33, 33:22-47, 36:59-67, 37:4-15, and 42:36-59) does not disclose both "receiving, from a computer connected to a

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[1] *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

computer network, a citizen's request regarding status of at least one of the citizen's voter registration and the citizens electronic ballot status" and "determining a status message in response to the step of receiving".

FF5. Bayer discloses a system for conducting surveys over a network with survey voter registration (Title).

FF6. Bayer discloses that the system conducts surveys to voters and registers voters over a network. The system allows a survey form page to be transmitted the voters computer which enables the voter to answer each question and submit such answers back to the network server. The system allows voters to register at the registration site which may be linked to a voting campaign. (Abstract).

FF7. Bayer discloses that a registration questionnaire is sent to the network client computer to enable the registrant to register for the registration campaign and send the information back to the network server 12 (Col. 29:64-30:16).

FF8. Bayer discloses that a voter who has already voted is not permitted to revote through the use of a Voting Digital ID which is transmitted to the voter's computer and stored on the computer as a cookie (Col. 3:24-37).

FF9. Bayer does not disclose transmitting an electronic ballot to a second computer in (Col. 3:24-37).

FF10. *Webster's New World Dictionary of American English*, Third College Edition, 1988, defines "status" in a relevant third definition as: 3. state or condition, as of affairs.

PRINCIPLES OF LAW

Principles of Law Relating to Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim.

Principles of Law Relating to Obviousness

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls"). In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art."

ANALYSIS

Rejections under 35 U.S.C. § 103(a)

The Appellants argue that the rejection of claim 1 is improper because "There is no teaching or suggestion in the cited portions of the Bayer patent of a system that can actually establish that a voter is registered, such that the registered voter can receive a blank ballot upon request at a second computer" (Br. 10)(emphasis original). The Appellants argue that claim 1 recites "transmitting a blank electronic ballot, upon request by the registered voter at a second computer" which is not shown by McClure and Bayer (Reply Br. 2). The Appellants also argue that the Bayer patent is directed to a system for conducting surveys of voters in different languages.

In contrast the Examiner has determined that claim 1 is properly rejected under McClure and Bayer (Ans. 24). The Examiner has determined that McClure and Bayer disclose the claimed limitations and that it would have been obvious to modify McClure's voter system to include the registration features of Bayer to have their functions combined together instead of done separately (Ans. 26).

We agree with the Appellants. In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445. *See also Piasecki*, 745 F.2d at 1472. Here, McClure discloses an electronic voting system (FF1) which the Examiner has acknowledge does not disclose transmitting a blank

registration form upon request at a first computer to the first computer (Ans. 4) as claimed. Claim 1 also requires:

> "*transmitting a blank electronic ballot, upon request by the registered voter at a second computer*, from the computer database that resides on the transaction repository server, via the transaction mediator, *to the second computer*" (emphasis added).

Thus the claim requires that *upon the request of a registered voter from a second computer*, *a blank electronic ballot* is transmitted to the *second computer*. McClure has disclosed an electronic voting system in which the casting of the ballot may be conducted over the Internet if the voter is registered (FF1). However McClure discloses that an identification file requires the voter to register and cast their vote from the *same computer* (FF2). Should the file become corrupted or the voter change computers, they have to start over with the request to vote (FF2). At Col. 37:4-20 McClure does not teach transmitting an electronic ballot to a second computer (FF3) despite the Examiner's assertions. Bayer at Col. 3:24-37 also does not disclose transmitting an electronic ballot to a second computer and the Examiner has not asserted that Bayer discloses this (Ans. 5-6). McClure and Bayer both fail to show the transmitting an electronic ballot to a second computer and the rejection of record therefore fails to establish a prima facie case of obviousness. For these reasons the rejection of claim 1, and claims 23 and 32 which contain similar limitations, is not sustained. The rejection of the dependent claims 2-19, 24-31, and 33-40 is not sustained for these same reasons.

Rejections under 35 U.S.C. § 102(e)

The Appellants argue that the rejection of claim 41 is improper because McClure fails to disclose the "transaction mediator being operative to transmit registration information from a first computer….so that a voted electronic ballot can be transmitted from a second computer" (Br. 11-12). The Appellants also argue the rejection of claims 20 and 46 is improper because McClure does not teach any ability to make a request for the voters registration or electronic ballot status (Br. 12). The Appellant also argues that claim 20 recites that a "status message" is determined in response to one of requests regarding the status of the registration or ballot which is not shown by McClure (Reply Br. 3-4)

In contrast the Examiner has determined that the rejections are proper and that McClure implicitly and inherently initiates a request for that status of voter registration when voting (Ans. 27-28).

We agree with the Appellants. Claim 41 includes a limitation which requires that "the transaction mediator being operative to transmit registration information from a first computer….*so that a voted electronic ballot can be transmitted from a second computer*". In contrast McClure has disclosed that the identification file *requires* the voter to register and *cast their vote from the same computer* (FF2) so for this reason the rejection of claim 41 and dependent claims 42-45 is not sustained.

Claim 20 includes limitations for: "receiving …a citizen request regarding status of at least one of the citizen's voter registration and the citizens electronic ballot status", "determining a status message in response to the step of receiving", and then "transmitting the status message." The

Examiner appears to assert that by voting the citizen in McClure's reference implicitly makes a status request regarding registration which is required to vote (Ans. 27-28). A relevant dictionary definition defines "status" as "state or condition, as of affairs" (FF10). There is a distinction between a citizen "registering to vote and voting" and that of both: "receiving…a citizen's request regarding *status* of at least one of the citizen's voter registration and electronic ballot status" and also "*determining a status message in response to the step of receiving*" as claimed. McClure in the sections referenced by the Examiner does not disclose both "receiving, from a computer connected to a computer network, a citizen's request regarding status of at least one of the citizen's voter registration and the citizens electronic ballot status" *and* "determining a *status message in response to the step of receiving*" together. (FF4). While the system of McClure would check the registration of the voter before allowing them to vote, it is not disclosed that there is also "a determining [of] a status message in response to the step of receiving" as claimed. While the Examiner has asserted that such a status message would be inherent, this cannot be established beyond possibilities and probabilities. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted). For this reason the rejection of claim 20 and its dependent claims 21-22 is not

sustained. Claim 46 contains limitations similar to claim 21 and the rejection of this claim is not sustained for the reasons above as well.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-19 and 23-40 under 35 U.S.C. § 103(a) as unpatentable over McClure and Bayer.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 20-22 and 41-47 under 35 U.S.C. § 102(e) as being anticipated by McClure.

DECISON

The Examiner's rejection of claims 1-47 is reversed.

REVERSED

MP

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